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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/827,390	04/19/2004	Lowell L. Wood JR.	SE1-0034C3-US	3132

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Constellation Law Group, PLLC
P.O. Box 220
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EXAMINER

MEDWAY, SCOTT J

ART UNIT	PAPER NUMBER
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3763

MAIL DATE	DELIVERY MODE
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10/29/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/827,390	Applicant(s) WOOD, LOWELL L.	
	Examiner SCOTT MEDWAY	Art Unit 3763	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 July 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-100 is/are pending in the application.
- 4a) Of the above claim(s) 42-99 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-41 and 100 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 19 April 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>06/22/2009</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

This is the second Office Action based on the 10/827390 application filed 04/19/2004. Examiner acknowledges the reply filed 07/23/2009.

Claims 1-41 and 100 are currently pending and are considered below. Claims 1-8 have been amended. Claim 100 is newly added.

Claim Rejections - 35 USC § 102

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

2. Claims 1-6, 8, 10, 21, 23-25, 27, 30, 32, 33-41 are rejected under 35 U.S.C. 102(b) as being anticipated by Hall et al (U.S. Pat. 6,385,472 B1).

Regarding claims 1-6, 8, 10, 21, 23-25, 27, 30, 32, 33-41, Hall discloses a system with a body portion (e.g., a body portion of a human, such as a circulatory system), an extending part with a proximal end piece and at least one distal end piece configured to telescopically extend from the proximal end piece; at least one receiving body; and a control circuit with a processor and stored software coupled to the receiving body (see Figs. 1 and 6; col. 3, lines 33-35; col. 5, lines 30-34) and suitable for controlling the system. The extending part comprises two or more distal pieces (see Fig. 1) and the distal end pieces are configured to slidably collapse within an interior of the proximal end piece; the extending part comprises a decreasing size and/or dimension for traveling the interior of a blood vessel (see Fig. 1); and the extending part

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comprises a hollow portion (see Fig. 1); the size of one or more distal end pieces is less than a size of a proximal end piece (see Fig. 1); the system further comprises a motor (col. 7, lines 65-67); the system further comprises a source of a chemical (col. 2, lines 26-28) and is capable of dispensing fluid through a dispenser at the end of the device; or a functional tool (46) and a tool positioner, which is capable of ablation (col. 2, lines 25-27).

Claim Rejections - 35 USC § 103

3. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

4. Claim 7, 22 and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hall et al (U.S. Pat. 6,385,472 B1).

Regarding claim 7, it is noted that Hall does not disclose a two-fold decrease in diameter of each of a successive hollow sliding part. It would have been obvious for one of ordinary skill in the art at the time of the invention to form the hollow sliding parts to have a two-fold decrease in diameter for each successive part, since such a modification would have involved a mere change in the size of a component which is recognized to be within the level of ordinary skill in the art. *In re Rose*, 105 USPQ 237 (CCPA 1955).

Regarding claim 22, it is noted that Hall does not disclose a source of two or more of a chemical, chemical compound or biological material. It would have been

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obvious for one of ordinary skill in the art at the time of the invention to provide a source of two or more of a chemical, chemical compound or biological material, since it has been held that duplicating the essential working parts of an invention (e.g., the source of a chemical) involves only routine skill in the art. *St Regis Paper Co. v. Bemis Co.*, 193 USPQ 8.

Regarding claim 26, it is noted that Hall does not disclose a second control circuit. It would have been obvious for one of ordinary skill in the art at the time of the invention to provide a second control circuit, since it has been held that duplicating the essential working parts of an invention (e.g., a control circuit) involves only routine skill in the art. *St Regis Paper Co. v. Bemis Co.*, 193 USPQ 8.

5. Claims 9, 11-20, 28, 29 and 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hall et al (U.S. Pat. 6,385,472 B1) in view of Iddan (U.S. Pat. 6,936,003 B2).

Regarding claim 9, 28, 29, and 31, it is noted that Hall does not comprise a pump. Iddan discloses an extendable element in the analogous art to Hall, comprising a pump suitable for storage (see Fig. 1C) and a portion at the end of the extendable element for degrading a mass of cells and storing them. Iddan also teaches a portion for tissue welding (i.e., cauterizing), ablating and/or a stent (col. 3, line 62 to col. 4, line 25). It would have been obvious for one of ordinary skill in the art at the time of the invention to provide a tool for degrading cells and a pump for pumping the cells out of an animal, so as to analyze the stored samples to provide more personalized and

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accurate care for a patient. It would have been obvious to additionally provide an cauterizing or ablation tool, or a stent, since such tools and apparatuses are well known for being attached to an extendable portion and would be useful for providing a wider variety of in vivo function or procedures.

Regarding claims 11-16, it is noted that Hall does not disclose a polymer operative for converting electrical energy into mechanical energy to move a fluid. Iddan teaches electroactive polymers suitable to convert electrical energy into mechanical energy so as to move a conduit containing a fluid receivable to a location. It would have been obvious for one of ordinary skill in the art at the time of the invention to implement the electroactive polymers of Iddan in the device of Hall so as to more accurately control a tractable conduit in a sensitive body orifice or vessel.

Regarding claims 17-20, it is noted that Hall does not disclose coupling a sensor or a wireless interface with a transmitter/controller to the system. Iddan teaches sensors (see Abstract) as well as wireless data receivers/transmitters (see Abstract) being attached to an extendable element. It would have been obvious for one of ordinary skill in the art at the time of the invention to outfit the device of Hall with sensors and/or wireless data receivers/transmitters as taught by Iddan, since sensors would be useful for providing enhanced feedback at the treatment site, and wireless systems would be useful for performing procedures and/or obtaining data at a remote site.

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6. Claim 100 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hall et al (U.S. Pat. 6,385,472 B1) in view of Douk (U.S. Pub. 2005/0027236 A1).

Regarding claim 100, it is noted that Hall does not disclose that the proximal end piece and one or more distal end pieces are configured to articulate at one or more joints of adjacent pieces. Douk discloses a telescoping catheter in the analogous art to Hall, where the joints of telescoping distal pieces are configured to articulate at one or more joints (see Figs. 1-3). It would have been obvious for one of ordinary skill in the art at the time of the invention to configure the proximal and distal end pieces to articulate at one or more joints so as to ensure that the distal pieces have a maximum configurable extension length suitable for a specific medical procedure.

Response to Arguments

7. Applicant's arguments with respect to claims 1-41 and 100 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Applicant is directed to the *Notice of References Cited*.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to SCOTT MEDWAY whose telephone number is (571) 270-3656. The examiner can normally be reached on Monday through Friday, 7:30 AM to 5:00 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nicholas Lucchesi can be reached on (571) 272-4977. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a

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/Scott J. Medway/
Examiner, AU 3763
10/14/2009

/Nicholas D Lucchesi/
Supervisory Patent Examiner, Art Unit 3763